

Serial No. 10/797,486

**RECEIVED
CENTRAL FAX CENTER**

Pre-Appeal Brief

APR 17 2007

UTILITY PATENT

B&D No. JK01261

IN THE UNITED STATES PATENT AND TRADEMARK OFFICEIn re application of: **Matthew A. SMITH et al.**

Serial No.: 10/797,486


Examiner: **P. Nguyen**Filed: **March 10, 2004**Group Art Unit: **3724**For: **OPTICAL PROXIMITY DEVICE FOR POWER TOOLS**

Assistant Commissioner for Patents

Washington, DC 20231

PRE-APPEAL BRIEF REQUEST FOR REVIEW

I, Adan Ayala, PTO Reg. No. 38,373, hereby certify that this correspondence is being facsimile transmitted to the Patent and Trademark Office Fax No. (571) 273-8300 on 4-17-07


Adan Ayala

Dear Sir:

This is in response to the final Office Action of August 22, 2006. A Notice of Appeal has been filed herewith.

The Examiner rejected Claims 1-6, 8-13, 17-19, 22-28 and 32-34 under 35 USC § 103(a) as being unpatentable over US Pub. No. 2002/0017175 ("Gass") in view of US Patent No. 5,436,613 ("Ghosh"). In addition, the Examiner rejected Claim 21 under 35 USC § 103(a) as being unpatentable over Gass in view of Ghosh and further in view of US Pub. No. 2003/0169956 ("Lange"). Applicants request that these rejections be withdrawn.

Admittedly, Gass teaches a power tool with a working element for performing a task on a workpiece and a detecting system for detecting a human body part. However, Gass does not disclose a light source arranged to project a beam of light adjacent the interface between the

Serial No. 10/797,486

Pre-Appeal Brief

UTILITY PATENT

B&D No. JK01261

working element and the workpiece, or the detector detecting the presence of a human body part in the beam of light.

The Examiner relies on Ghosh for such teachings. In particular, the Examiner relies on a statement that infrared systems "have been used in designing detection systems of human presence." Ghosh, col. 1, lns. 24-33. However Ghosh does not teach how such infrared systems detect human presence, or how such system is structured.

Rather than provide a better reference that has more than just a one-sentence non-structural reference to an infrared system, the Examiner retorts that the "Applicant does not claim how the infrared systems detect human presence, or how such system is structured." This is incorrect. Claim 1 calls for "a light source arranged to project a beam of light adjacent the interface between the working element and the workpiece; and a detector configured to detect the presence of a human body part in the beam of light, wherein the detector is communicatively coupled to the power tool so as to stop operation of the working element." Applicants submit that such claimed language show (a) how the system detects a human presence, i.e., the detector detects the presence of a human body part in the beam of light, and (b) how such system is structured, i.e., a light source and a detector connected to the power tool. Ghosh does not discuss any such elements.

Furthermore, the Examiner has not met the *prima facie* case of obviousness for combining Gass and Ghosh for several reasons.

First, according to MPEP § 2143, the Examiner must show that there is "some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings."

Serial No. 10/797,486

Pre-Appeal Brief

UTILITY PATENT

B&D No. JK01261

In the present case, there is no suggestion or motivation to Gass's detection system with the infrared system mentioned in Ghosh because Ghosh does not suggest the desirability of the claimed invention. According to MPEP § 2132.01(I), "the prior art must suggest the desirability of the claimed invention." Ghosh does not suggest the desirability of using a light source for detecting a human body part.

The Examiner argues that Ghosh teaches many detection systems, that choosing one is a routine skill, and thus choosing the infrared system from Ghosh's list would have been obvious. This contradicts MPEP § 2143.01(IV), which requires more than just the capabilities of one of ordinary skill to modify the prior art to meet the claimed invention, even when the references relied upon teach that all aspects of the claimed invention were individually known in the art. Such skill is not sufficient to establish a *prima facie* case of obviousness without some objective reason to combine the teachings of the references. *Ex parte Levengood*, 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993). The Examiner does not point to any such objective reason.

This is not surprising as Ghosh explicitly declares that "none of the prior art devices identified above is capable of discriminating between a human and an inanimate object." Ghosh, col. 2, lines 66-68.¹ Ghosh thus teaches away from using infrared systems and teaches persons skilled in the art to use instead capacitive systems. Ghosh, col. 4, lines 30-34. Accordingly, Ghosh does not teach the desirability of the claimed invention which relies on light, rather than capacitive systems.

¹ The Examiner has argued that such statement applies to the capacitive detection systems, not to the infrared systems. Applicants submit that the statement is clear: none of the prior art devices discussed, including those listed in col. 1, lines 26-32, are capable of discriminating between a human and an inanimate object.

Serial No. 10/797,486

Pre-Appeal Brief

UTILITY PATENT

B&D No. JK01261

Furthermore, if the “proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification.” MPEP § 2143.01(V) (citing *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984)).

The intended purpose of Gass is to stop motion of the blade when a human body part is detected, not when a workpiece contacts the saw blade. If Gass and Ghosh are combined, the resulting power tool will stop motion of the blade when either a human body part or an inanimate object is detected, as Ghosh’s infrared system is unable to “discriminat[e] between a human and an inanimate object.” Ghosh, col. 2, lns. 66-68. Such modification would render the Gass device unsatisfactory for its intended purpose, i.e., stop motion of the blade when a human body part is detected, but not when a workpiece contacts the saw blade. Therefore, there is no suggestion or motivation to make proposed modification. The Examiner does not have a response to this argument.

Furthermore, because of this failure, the Examiner cannot show “the reasonable expectation of success” for a prima facie case of obviousness to exist under MPEP § 2143. Again, it would be unreasonable to expect that Gass and Ghosh’s infrared system would be able to “discriminat[e] between a human and an inanimate object,” when Ghosh admits that its own infrared system cannot do so.

Finally, for a prima facie case of obviousness to exist, the prior art references “must teach or suggest all the claim limitations.” MPEP § 2143. In the present case, Ghosh is silent as to the structure of the infrared system, a fact not disputed by the Examiner. Accordingly, there is no teaching, for example, as to where the infrared light should be directed or how to detect the

Serial No. 10/797,486

Pre-Appeal Brief

UTILITY PATENT

B&D No. JK01261

human body part. Accordingly, even if Gass and Ghosh were combined, such combination would not show "a light source arranged to project a beam of light adjacent the interface between the working element and the workpiece," as called for in Claim 1.

Because the Examiner has failed to establish all three elements required for a prima facie case of obviousness, the Examiner cannot combine Gass and Ghosh to render unpatentable Claim 1 and its dependent claims.

Furthermore, independent Claims 8 and 22 have similar elements, such as the light source and the detector configured to detect the presence of a human body part. Similarly, because the Examiner has failed to establish all three elements required for a prima facie case of obviousness, the Examiner cannot combine Gass and Ghosh to render unpatentable Claims 8 and 22 and their respective dependent claims.

In view of the foregoing, allowance of Claims 1-6, 8-13, 15-28 and 30-51 is respectfully requested.

Respectfully submitted,



Adan Ayala
PTO Reg. No. 38,373
Attorney for Applicants

Adan Ayala - TW-199
The Black & Decker Corporation
701 East Joppa Road
Towson, Maryland 21286
(410) 716-2368